

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nancy C. Frye
Serial No.: 10/790,923
Filing Date: March 1, 2004
Confirmation No.: 1435
Group Art Unit: 3728
Examiner: Marie D. Paterson
Title: SHOE AND LAST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Final Action issued December 26, 2007, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notices of July 12, 2005 and January 10, 2006. Pursuant to the Official Gazette Notices, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified by the claims. The drawings submitted to address this objection were not entered due to a new matter objection. Claims 1, 5, and 11 currently stand rejected under 35 U.S.C. §102(b) as being anticipated by Snabb, et al. Claims 8, 14, 16, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Snabb. Claims 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Snabb, et al. in view of Borgeas. In the prosecution of the present Application, the Examiner's objections, rejections, and assertions contain clear errors of law, including a failure to establish a prima facie case of obviousness. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

In the Final Action of December 26, 2007, the Examiner indicated that the drawings are objected to for not including a midsole as specified in the claims. Applicant submitted a replacement drawing sheet including a midsole as requested by the Examiner. The Examiner objected to the replacement drawing sheet as containing new matter. Applicant's specification provides support for the use of a midsole in the claimed shoe. See page 29, lines 11-13, where insole 816 may be in direct contact with surface 818 of outsole 812 or may be separated therefrom by one or more midsoles. The replacement

drawing sheets requested by the Examiner does no more than show a midsole separating an insole from an outsole as expressly disclosed in Applicant's specification. As a result, no new matter has been added to the drawings that is beyond the disclosure of Applicant's specification.

Most notable of the legal errors present in the examination of the Application is a failure of the Final Action of December 26, 2007 to establish a prima facie case of anticipation and obviousness of the claims rejected under 35 U.S.C. §103(a). Independent Claims 1 and 11 recite in general an insole configured with a constantly thick forward toe section and a decreasingly thick rear heel section with the constantly thick forward section meeting the decreasingly thick rear heel section at a point substantially halfway point with respect to the upper or outsole of the shoe. By contrast, the Snabb, et al. patent clearly states that a forward toe section of its outer sole 20 does not have a constant thickness until location 29. Location 29 is not at a halfway point with respect to the shoe upper or outsole as required by the claimed invention. In fact, location 29 is underneath the toes of the wearer's foot and would never be considered to be at a halfway point of an upper or outsole of a shoe. Moreover, the Snabb, et al. patent at col. 3, lines 48-50, clearly teaches away from having this feature at a halfway point of the shoe. In addition, the negative slope of the shoe of the Snabb, et al. patent is clearly caused by the outer sole 20 and not the inner sole 24 as shown in FIGURE 2. The Snabb, et al. patent specifically states that its inner sole 24 is substantially flat both laterally and longitudinally. (See FIGURE 5 and col. 3, lines 50-53, of the Snabb, et al. patent). As a result, the inner sole 24 of the Snabb, et al. patent is not capable of providing the structure required by the claimed invention.

The Examiner asserts that the Snabb, et al. patent has an insole with a constant thickness to point 28 under the ball of a wearer's foot. This position is not supported by the disclosure or drawings of the Snabb, et al. patent. First, the various thicknesses of the shoe of the Snabb, et al. patent is based on its outer sole 20 as its inner sole 24 is explicitly described as being both laterally and longitudinally flat. Thus, the express lateral and longitudinal flatness of the inner sole 24 of the Snabb, et al. patent means it cannot have a rear heel section with a decreasing slope as required by the claimed invention. The claimed invention describes an insole that has a longitudinal change in structure at a halfway point of the shoe. Second, the Snabb, et al. patent clearly states that the slope is decreased to 0 degrees under the toes at point 29, forward and beyond the ball centers of pressure at point 28. (See col. 4, lines 37-40, of the Snabb, et al. patent). As a result, there is no constant thickness at point 28 let alone at a point substantially halfway with respect to an upper or outsole of a shoe as required by the claimed invention. For arguments sake, even if it is assumed that the slope is 0 degrees at point 28, this would still never be considered to be at a halfway point of an upper or outsole of a shoe. The Examiner relies on original FIGURE 14 to equate the shoe of the Snabb patent to the claimed invention. Original FIGURE 14 misidentified the halfway point of the shoe. This misidentification was pointed out by the Examiner and a request was made by the Examiner to correct the confusion. The replacement drawing sheet corrected the misidentification of the halfway point as requested by the Examiner in order to provide consistency with Applicant's specification at page 29, lines 16-20. Thus, the Snabb, et al. patent fails to teach each and every limitation of the claimed invention as required to support an anticipation rejection.

CONCLUSION

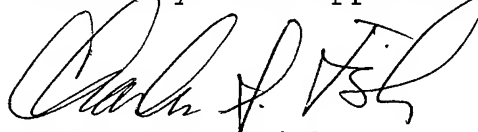
Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in dark ink, appearing to read 'Charles S. Fish', is written over the printed name.

Charles S. Fish

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March 26, 2008

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